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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/879,683
Filing Date: June 11, 2001
Appellant(s): SCHWEITZER, LIMOR

Kevin J. Zilka
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/4/2008 appealing from the Office action mailed 6/26/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application No. 09/879,682. Appeal Brief filed 1/9/2008, no decision has been rendered to date.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. No amendment after final was filed by the applicant. The final rejection was mailed 6/26/2007.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,905,736	Ronen	5-1999
5,794,221	Egendorf	8-1998
6,332,134	Foster	12-2001
5,899,980	Wilf et al.	5-1999

Stewart, John. "Connecting With Confidence" Web Techniques. San Francisco: Apr 2000. Vol. 5, Iss. 4; pg. 84, 3 pgs.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3, 8-12, 27, 28, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1: This claim is indefinite for the following reasons:

(a) The claim recites the limitation "the information" in line 9. There is insufficient antecedent basis for this limitation in the claim. Is this limitation referring to received information or shipping information?

(b) The meaning of the limitation "wherein the site sends the information..." is unclear. Where is the information being sent?

Claims 3, 8-12, 27, 28, 30 are rejected because of their dependency to the rejected claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 8-11, 13, 20-23, 25-28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen (U.S. Patent No. 5,905,736) in view of Egendorf (U.S. Patent No. 5,794,221) in further view of Foster (U.S. Patent No. 6,332,134).

Re claims 1, 13, 25: Ronen disclose a method, computer program product, and system comprising:

receiving information utilizing a network, wherein the information includes an Internet Protocol (IP) address of a user and an amount of payment due ("the ISP transmits to the billing platform the IP address identity of the user making the transaction and the cost associated with the transaction")-see col. 2 lines 13-16;

identifying an account using at least a portion of the IP address; and administering payment for the payment due by billing against the account; wherein the receiving, the identifying, and administering are carried out by a network service provider. ("The billing server then cross-references the IP address associated with the cost...with the IP address/transaction received from the ISP to properly charge an

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established account of the user for the transaction...")-see col. 2 lines 16-30, cols. 3-4 and ("In parallel with the ISP providing service to the user..., the ISP signals the transaction server to bill the account associated with the IP address to which the ISP is providing service... the transaction server bills that account...")-see col. 7 lines 61-67 and ("IAP" Internet access provider) cols. 2-9, and Abstract.;

wherein user data is identified based on the received information, and the user data is sent to a site ("Before completing the transaction, therefore, the accessed ISP, such as ISP 106, communicates with the transaction server 109 to determine whether that IP address has an established billing entry to which charges for the transaction can be forwarded and recorded. Such communication can take place over a dedicated private link 117 between ISP 106 and transaction server109, or over a secured Internet link...If such an entry exists on database 110, ISP 106 is signaled over the secured link, to authorize the transaction...")-see col. 5 lines 52-67; cols. 2, 5, 6;

wherein the site sends the information in response to the user carrying out a transaction using the site ("In response to a chargeable transaction with an ISP, the ISP transmits to the billing platform the IP address of the user making the

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transaction and the charge for the transaction")-see Abstract, col. 2 lines 5-30;

wherein a uniform resource locator (URL) link is provided to the user from the site, where the URL allows the user to give permission for the payment to be administered ("If no billing mechanism has been established, then at step 218 (in FIG. 4), the ISP sends the user a URL to an HTML page for selecting a billing mechanism...the billing mechanism will include the user's desired method or methods of billing, and any parameters that define when a particular billing method is to be applied.")-see col. 7 lines 34-40, FIGS. 2-4,

and, in response to the user giving the permission, the site receives confirmation ("At decision step 214, if the presence of a billing mechanism is confirmed, at step 223, the ISP receives confirmation from the transaction server and provides the requested service to the user, the latter including delivery of the requested information, the downloading of requested software, or a confirmation of an order...")-see col. 4 lines 52-67.

Although Ronen discloses a confirmation received from the transaction server, Ronen and Egendorf do not specifically disclose that the site is provided with a confirmation number

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and shipping information of the user and the user is provided with the confirmation number. Foster however, teaches a financial transaction system conducted using the Internet which discloses ("The message to the cardholder, shown at path 216 may be an order confirmation number or indication that the order is to be placed. The message to the merchant includes a unique order number and a pre-registered shipping address or an authorized alternate shipping address, as shown at path 218...")- see col. 8 lines 42-63 and cols. 7-8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen and Egendorf to specifically include that the merchant is provided with a unique order number and a shipping address of the user and that the cardholder is provided with an order confirmation number as taught by Foster in order to inform the merchant that the product can be shipped and will be paid for by the customer and to inform the customer that the financing for the product has been approved and the order has will be processed by the merchant.

Although Ronen disclose the purchasing of goods that will later be delivered by conventional transport means-see col. 1 lines 1-19, and ("These ISPs can also offer the user the ability to order tickets, or tangible goods from a retailer or Internet-

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order company associated with the ISP, or from a plurality of different such companies...")-see col. 3 lines 33-37, Ronen do not specifically disclose wherein the user data includes shipping information. Egendorf however, teaches an Internet billing method comprising the establishment of an agreement between an Internet access provider, customer, vendor and ("address supplied by the customer for shipment of the goods...")-see col. 4, lines 1-6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to specifically include that user data includes shipping information as taught by Egendorf in order for the vendor to ship products to the correct user destination. Furthermore, Ronen discloses the purchasing of goods that will later be delivered by conventional transport means. It is obvious that in order for goods ordered online to be shipped to a consumer, the consumer must provide shipping information.

Re claims 8, 11, 20,23: Ronen disclose limiting the administration of payment based on a rule and wherein the account is a debit account-see col. 7 lines 37-40, Fig. 1 (120-3).

Re claims 9 and 10: Ronen do not specifically disclose collecting a fee from the site and the fee is a percentage of the payment due. Egendorf however, teaches ("The provider then

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bills the transaction amount to the customer and remits a portion of the transaction amount to the vendor, keeping the differential as a fee for providing the service")-see Abstract, and col. 4, lines 18-22. Official notice is taken that it is old and well known in the art of e-commerce that a fee is a percentage of payment due. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include charging a fee as a percentage of payment due as taught by Egendorf and is old and well known, in order for the provider to generate income from the services provided to the vendor and consumer.

Re claims 21, 22: Further a computer program product would have been necessary to perform the method of previously rejected claims 9 and 10 and are therefore rejected using the same art and rationale.

Re claim 26: Ronen disclose: (a) providing a link to a site on a network where a business transaction is occurring; and (b) receiving information from the site at a third party location during the transaction wherein the information includes an Internet Protocol (IP) address of a user and an amount of payment due -see cols 1-2. The remaining steps have similar limitations found in claims 1, 8, 9 above, and therefore are rejected by the same art and rationale.

Re claim 27: Ronen disclose wherein the information is received from a combination of the user and a site, where the information is received from the site in response to the user carrying out a transaction using the site.-see col. 2.

Re claim 28: Ronen disclose wherein the account is identified utilizing a database which links the information with a corresponding account. -see col. 2 lines 16-30, cols. 3-4.

Re claim 30: Ronen disclose wherein the rule identifies at least one category in which goods or services are permitted to be purchased.-see col. 4, in particular parameters of billing and the billing choice and Table 1.

3. Claims 12, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen, Egendorf, and Foster in further view of Wilf et al. (hereinafter Wilf, U.S. Patent No. 5,899,980).

Re claim 12: Ronen, Egendorf, and Foster do not specifically disclose wherein the steps are carried out by a financial institution offering credit with credit cards in conjunction with a network service provider. Wilf however, teaches ("The STSP, the customers, the vendors and the ISPs receive financial services from one or more financial service providers...")-see col. 7 in particular, lines 26-33. It would

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have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen, Egendorf, and Foster to include a financial service provider offering services as taught by Wilf in order to provide the customer with convenient payment options.

Re claims 24: Further a computer program product would have been necessary to perform the method of previously rejected claims 12 and are therefore rejected using the same art and rationale.

4. Claims 3,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen, in view of Egendorf, in view of Foster, in further view of Stewart (Stewart, John. *Connecting with Confidence*. Web Techniques. San Francisco: Apr 2000. Vol. 5, Iss. 4; pg. 84, 4 pgs.

Re claim 3: Although Ronen refers to identifying information relating to a customer such as an internet address - see col. 2, Ronen does not specifically disclose wherein the information further includes port numbers.

It is well known in the art as evidenced by Stewart, that port numbers are a way to identify a specific process to which an internet message is to be forwarded when it arrives at a server.

("The rules are simple: Control which machines (using IP

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addresses) can talk to one another on what services [using network port numbers].")-see p. 3, para. 2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include identifying a transaction by using a port number, as was taught by Stewart in order to control the transfer of information over the Internet.

Re claim 15: Further a computer program would have been necessary to perform the method of previously rejected claim 3 and is therefore rejected using the same art and rationale.

(10) Response to Argument

In response to the Appellant's argument regarding the 35 U.S.C. 112, second paragraph rejection of claims 1, 3, 8-12, 27, 28, and 30 due to lack of antecedent basis for the limitation "the information" in line 9, the Examiner maintains the rejection because it is unclear which information the limitation is referring, (i.e., received information or shipping information).

In response to the Appellant's argument concerning the indefiniteness of the limitation, "wherein the site sends information in response to the user carrying out a transaction using the site." recited in claim 1, the Examiner maintains the rejection. This limitation is confusing. It is unclear what is in fact being accomplished by the site, what information is

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being sent by the site, and finally to whom the information is being sent. The claim limitation is vague and indefinite and does not allow for a clear understanding of the invention.

In response to the Appellant's argument regarding claims 1, 13, and 25, and that Ronen do not disclose "wherein user data is identified based on the received information and the user data is sent to a site, wherein the user data includes shipping information", the appellant's attention is directed to columns 2, 5, and 6 wherein Ronen disclose a billing platform which uses the IP address identity of the user [received information].

In particular, col. 1 lines 13-20, Ronen disclose that the billing server cross-references the IP address associated with the cost of the transaction received from the ISP with the IP address/user-identity relationship received from the IAP to properly charge an established account of the user [user data is identified]. Ronen disclose that the user data [IP address of the user] is sent to a site-see col. 5 lines 64-65 "ISP 106 is signaled over the secured link to authorize the transaction", and Figs. 2 -3 user's IP address. Ronen further disclose a user inputs a service request that will incur a transaction charge- col. 7 lines 7-14.

Ronen further disclose that it is old and well known in the art of online shopping for the user to provide an ISP with

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billing information such as credit card number [user data].

Ronen disclose the ordering of various goods and services being delivered by conventional transport means is old and well known in the art of online shopping. It is obvious from Ronen that in order to deliver goods via conventional transport means, the ISP must be provided with the user's shipping information.-see Background of the Invention, col. 1.

Furthermore, Egendorf teaches "In a typical transaction in accordance with the present invention, from the customer's point of view all use of the Internet appears to be conventional...If the vendor wishes, the vendor [site] may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer..." -see col. 3 line 40 to col. 4 line 6.

In response to the Appellant's argument that the Examiner is relying on inherency, the Appellant is reminded that the claims are rejected under 35 U.S.C § 103, and the Appellant is directed to p. 7 of the Office Action wherein the Examiner clearly refers to the obviousness of the claim limitations.

In response to the Appellant's argument that Foster does not teach the site is provided with a confirmation number and the shipping information and the user is provided with the confirmation number. Ronen disclose ("At decision step 214, if

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the presence of a billing mechanism is confirmed, at step 223, the ISP receives confirmation from the transaction server and provides the requested service to the user...the ISP receives confirmation that such an account has been billed.")-see col. 7, lines 52-67. Foster teaches that once the cardholder and merchant agree on a transaction, a confirmation message including a confirmation number is sent to the cardholder and a unique order number and cardholder shipping address is sent to the merchant.-see Fig. 3 and col. 8 lines 42-53. Furthermore, the Examiner cited prior art made of record and not relied upon considered pertinent to Appellant's disclosure on page 12 of the final office action, in particular, US PG. Publication No. 2002/0069165 (O'Neil) discloses a confirmation number displayed to the user and to the merchant-see pars. [0026-0027].

Claims 1,13, and 25 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR* (*KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396).

In addition, neither the Appellants' Specification nor Appellants' arguments present any evidence that modifying Ronen with the selected elements of Egendorf and Foster was uniquely challenging or difficult for one of ordinary skill in the art.

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Under those circumstances, the Examiner did not err in holding that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include the specific teaching of the user data including shipping information as taught by Egendorf and specific teaching of a confirmation number and user shipping information provided to the site and a confirmation number provided to the user of Foster in order to provide the merchant (site) with payment confirmation as well as an address to ship the merchandise. Because this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis is required by the Examiner. *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396.

In response to the Appellant's argument regarding claim 26, and that Ronen do not disclose "providing a link to a site on a network where a business transaction is occurring." The Appellant's attention is directed to col. 1 wherein Ronen discloses accessing the Internet which provides users a mechanism for ordering goods and services. Ronen further discloses allowing the user interacts with a transaction server to provide his or her selected choices for how charges for a transaction on the Internet are to be billed, in particular, see

Fig. 1 (refs. 101, 103,104,115,116,109,111) and related text;
cols. 4-5.

Regarding the Appellant's argument that Ronen do not disclose in col. 7, lines 37-40, Figure 1 item 120-3, "conditionally administering payment for payment due by billing against the account in accordance with any identified rules." Ronen disclose that a user has arranged for centralized billing functionality a record that includes the parameters of billing and the billing choice. Table 1 of Ronen discloses the user ID, and if a parameter is met [condition], administering payment as designated by the parameter [billing the account in accordance with identified rules]. In the example provided in table 1, if John Smith purchases tangible goods amounting to less than or equal to \$40.00, the Chase Debit Account will be used as the payment method. If John Smith purchases items from Sears, the parameter [condition] is that all purchases from Sears are to be billed using the Sears account. Therefore, Ronen teaches conditionally administering payment in accordance with identified rules.

Regarding claim 30 and the Appellant's suggestion that Ronen do not teach "wherein the rule identifies at least one category in which goods or services are permitted to be purchased." Ronen disclose "In addition, the user may specify

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that certain transactions, depending upon the type of transaction, be billed in a specific manner." -see col. 4 lines 27-65; col. 6 lines 20-23.

In response to the Appellant's argument with respect to claims 12 and 24 suggesting that Wilf do not disclose "wherein the receiving, the identifying, and the administering are carried out by a financial institution offering credit with credit cards in conjunction with the network service provider", the Examiner would like to point out that the claim recites that the financial institution in conjunction with the network service provider carry out the receiving, the identifying, and the administering. The claim language does not specify the roles performed by the financial institution and the network service provider, therefore, the claim is interpreted based on the broadest, reasonable interpretation. Wilf disclose a retail method over a wide area network including the steps of connecting one of the customer computer stations to one of the points of sale computer station, purchasing goods from the point of sale computer station by the customer operating the customer computer station, validating the purchasing by one of the transaction servers and one of the network service provider servers, charging the customer for the purchasing, the transaction including the steps of billing an account of the

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customer by the network service provider server a transaction sum and billing by the transaction server an account of the network service provider server the transaction sum, supplying the goods to the customer, and remitting a portion of the transaction sum to a vendor operating the point of sale computer station. Furthermore, Wilf disclose the information for associating a customer and the information for associating the vendor are stored on the transaction server or accessible to the transaction server. Wilf further disclose that the software module installed on the STSPs (secure transaction servers) can identify the ISP of a customer having an IP address by accessing a database or table. The software module also manages the financial information needed for implementing the billing such as the credit card account numbers of the ISPs and vendors. The STSP (secure transaction service providers, the customers, the vendors, and the ISPs receive financial services from one or more financial service providers such as a credit card company or bank or any other suitable financial service company. The financial service provider transfers the proper amounts from the ISPs to the relevant vendors. The financial service provider may also deduct a commission for itself and/or for the STSP and/or for the ISP.

Regarding claims 3 and 15 and the suggestion by the appellant that the Stewart reference does not disclose wherein information further includes port numbers and appellant's traversal of the official notice taken by the Examiner due to lack of support. The Appellant is reminded that the Examiner did take official noticed as evidenced by Stewart. Therefore, support was provided by the Examiner. Stewart teaches controlling network traffic includes controlling which machines (using IP addresses) can talk to one another on what services [using port numbers]. An internet port is a virtual entrance way between a user computer and the Internet. When an Internet connection is made, many of these virtual connections are opened up, and each has its own number and purpose. For example, FTP software usually connects to FTP servers using a designated port (usually number 21). The Stewart reference was used to support what is already well known in the art (i.e., port numbers are commonplace).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Elda Milef/

Examiner, Art Unit 3692

Conferees:

/Kambiz Abdi/

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Appeals Practice Specialist

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